

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Anders et al.	:	Shah, Amee A.
	:	
Serial No.: 10/759,931	:	Group Art Unit: 3625
	:	
Filing Date: January 16, 2004	:	
	:	
Title: SYSTEMS AND METHODS :	:	IBM Corporation
FOR CONFIGURABLE :	:	Intellectual Property Law
ENTITLEMENT :	:	11400 Burnet Road
MANAGEMENT :	:	Austin, Texas 78758

REPLY BRIEF UNDER 37 C.F.R. §41.41

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This Reply Brief is being submitted in response to the Examiner's Answer dated May 18, 2007, with a two-month statutory period for response set to expire on July 18, 2007.

I. RESPONSE TO EXAMINER'S ARGUMENTS:

- A. Response to Examiner's assertion that Svancarek discloses "wherein said step of determining if said recipient is entitled to said service comprises: comparing a set of administrator-configurable package profile attributes values associated with a package of services containing said service with corresponding values for said recipient" as recited in claim 1 and similarly in claims 10 and 19, as discussed on pages 6-7 of Examiner's Answer.

The Examiner asserts that Svancarek discloses "wherein said step of determining if said recipient is entitled to said service comprises: comparing a set of administrator-configurable package profile attributes values associated with a package of services containing said service with corresponding values for said recipient" as recited in claim 1 and similarly in claims 10 and 19. The Examiner's assertion is based on the alleged conclusion that a product key, as disclosed in paragraph [0031] of Svancarek, corresponds to a package of services. Examiner's Answer, page 6. Appellants respectfully traverse. A product key corresponds to a series of letters and digits that must be entered during software installation to authorize the user (see paragraphs [0011, 0032, 0033 and 035] of Svancarek). Hence, a product key does not correspond to a package of services as alleged by the Examiner. The pending claims must be given their broadest reasonable interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000); M.P.E.P. §2111. The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999); M.P.E.P. §2111. Since the Examiner has not provided a reasonable interpretation of the claimed package of services consistent with the specification or consistent with the interpretation that those skilled in the art would reach, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 1, 10 and 19. M.P.E.P. §2111.

Further, the Examiner asserts that paragraph [0034] of Svancarek discloses the aspect of comparing a set of administrator-configurable package profile attributes values associated with a package of services containing the service with

corresponding values for the recipient. Examiner's Answer, pages 6-7. Appellants respectfully traverse. Svancarek discloses that upon collecting all appropriate information, the portal 26 then sends such information to an eligibility service 28 that determines whether the user is qualified to obtain/purchase the desired product key 14. [0034]. Svancarek further discloses that the eligibility service 28 may employ most any business logic without departing from the spirit and scope of the present invention. [0034]. Svancarek additionally discloses that for example, such eligibility service 28 may determine whether the customer is in a participating region and/or has a participating software product 14. [0034]. Hence, Svancarek discloses that eligibility service 28 may determine whether the customer is in a participating region and/or has a participating software product 14.

There is no language in Svancarek that supports the Examiner's assertion that a comparison is made between a recipient value for a region and the package profile value for a participating region (see Examiner's Answer, page 7). Neither is there any language in Svancarek that supports the Examiner's assertion that a participating region is inherently administrator-configured (see Examiner's Answer, page 7). The Examiner appears to be asserting that Svancarek inherently discloses these aspects; however, the Examiner has not provided any evidence to support these assertions. How does the Examiner conclude a comparison is made between a recipient value for a region and the package profile value for a participating region when Svancarek is silent regarding the concept of values or silent regarding the concept of comparing values to determine if a customer is in a participating region? The Examiner must provide basis in fact and/or technical reasoning to support the assertion that Svancarek inherently discloses comparing a set of administrator-configurable package profile attributes values associated with a package of services containing the service with corresponding values for the recipient. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that Svancarek inherently discloses comparing a set of administrator-configurable package profile attributes values associated with a package of services containing the service with corresponding values for the

recipient, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 1, 10 and 19. M.P.E.P. §2131.

Further, assuming *arguendo* that a product key, as disclosed by Svancarek, may be interpreted as a package of services, and that a participating region, as disclosed by Svancarek, may be interpreted as a set of administer-configurable profile attribute values, how does this relate to the claimed language of "comparing a set of administrator-configurable package profile attribute values associated with a package of services containing said service with corresponding values for said recipient?" Using the Examiner's interpretations, the Examiner is comparing a participating region associated with a product key. How does this make sense? Neither does it make sense to assert that a product key contains the service with corresponding values for the recipient. The Examiner is misinterpreting the meaning of the claims as well as the language of Svancarek to conclude that Svancarek discloses the claim limitations of claims 1, 10 and 19. Since the Examiner has not provided a reasonable interpretation of the claims 1, 10 and 19 consistent with the specification or consistent with the interpretation that those skilled in the art would reach, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 1, 10 and 19. M.P.E.P. §2111.

- B. Response to Examiner's assertion that Svancarek discloses "if said service includes a limited number of accesses, decrementing a tracking count associated with the service" as recited in claim 4 and similarly in claims 13 and 22, as discussed on page 8 of Examiner's Answer.

The Examiner asserts that paragraphs [0040-0043] of Svancarek disclose the aspect of decrementing a tracking count associated with the service if the service includes a limited number of accesses. Examiner's Answer, page 8. Appellants respectfully traverse.

Svancarek instead discloses that once the transaction is complete, the distributor reports the distribution of the product key to a reporting service 32.

[0040]. Svancarek further discloses that the reporting service 32 may note that the particular copy of the software product 16 has the distributed product key 14 associated therewith, and can thus track how many product keys 14 have been distributed in connection with such copy. [0040]. Svancarek additionally discloses that the reporting service stores in the database a link between any information which was logged at the portal, allows the portal to discover such link when determining eligibility at a later time in connection with the copy of the software product, allows the provider to track the history of the copy of the software product and the distributed product keys therefor, and also can enforce any predefined business rules. [0041]. Additionally, Svancarek discloses that concomitant with the reporting service reporting the delivery of the product key to the database, such delivery is also reported to an activation database by the reporting service or by an intermediary between the databases. [0042]. In addition, Svancarek discloses that the activation database tracks each delivered product key with regard to whether same has already been employed to activate a corresponding software product on a particular computing device and if so pertinent activation information including an ID of such computing device. [0042]. Further, Svancarek discloses that the customer employs the delivered product key to activate the software product on a particular computing device by way of the product activation service and the activation database is updated to reflect that the product key has in fact been employed to activate the corresponding software product on the particular computing device as represented by the ID thereof. [0043].

Hence, Svancarek discloses a reporting service that tracks how many product keys have been distributed in connection with a copy of the software product. Further, Svancarek discloses tracking the history of the copy of the software product and the distributed product keys therefor. Further, Svancarek discloses updating the activation database to reflect that the product key has in fact been employed to activate the corresponding software product. However, there is no language in the cited passages that discloses that if the service includes a limited number of accesses, then a tracking count associated with the service is decremented. Thus, Svancarek

does not disclose all of the limitations of claims 4, 13 and 22, and thus Svancarek does not anticipate claims 4, 13 and 22. M.P.E.P. §2131.

Further, in connection with the rejection of the above-cited claim limitation, the Examiner appears to focus on the aspect of Svancarek's teaching of updating the activation database to reflect that the product key has in fact been employed to activate the corresponding software product as allegedly teaching the claimed aspect of decrementing the tracking count associated with the service. Examiner's Answer, page 8. Appellants respectfully traverse. How does the Examiner conclude that Svancarek's teaching of updating the activation database to reflect that the product key has in fact been employed to activate the corresponding software product reads on the claimed aspect of decrementing the tracking count associated with the service? The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that Svancarek's teaching of updating the activation database to reflect that the product key has in fact been employed to activate the corresponding software product reads on the claimed aspect of decrementing the tracking count associated with the service. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that Svancarek's teaching of updating the activation database to reflect that the product key has in fact been employed to activate the corresponding software product reads on the claimed aspect of decrementing the tracking count associated with the service, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999). Since the Examiner has not provided any such objective evidence, the Examiner has not presented a *prima facie* case of anticipation for rejecting claims 4, 13 and 22. M.P.E.P. §2131.

- C. Response to Examiner's assertion that Svancarek and Talbot, taken in combination, teach "wherein said substep of comparing a set of package profile attribute values associated with a package of services containing said service with corresponding values for said recipient comprises: for each profile attribute in said set of profile attributes, determining if a current attribute is single-valued; and if said current attribute is single-valued, determining said recipient is not entitled if a value of said current attribute and a corresponding value for said

recipient miscompare" as recited in claim 5 and similarly in claims 14 and 23, as discussed on pages 10-11 of Examiner's Answer.

The Examiner asserts that paragraph [0043] of Talbot teaches the aspect of determining if a current attribute is single-valued for each profile attribute, as recited in claim 5 and similarly in claims 14 and 23. Examiner's Answer, page 11. Appellants respectfully traverse.

Talbot instead teaches that if it is determined (step 502) that any of the single value exclusions apply, the credit request is filtered out (step 504) and will not be shown to that lender. [0043]. Talbot further teaches that if none of the single value exclusions apply, the credit request will be filtered by a second-pass filter (filter 2) involving multiple value factors. [0043]. Talbot additionally teaches that single value exclusions include: loan amounts below \$500,000; loan amounts above \$5,000,000; delinquent taxes; bankruptcy; Experian Business (SBI) score below 73; or Fair, Isaac & Company (SBSS) score below 300. [0036-0042]. Hence, Talbot teaches determining if a single value exclusion apply (e.g., loan amounts below \$500,000; loan amounts above \$5,000,000; delinquent taxes; bankruptcy; Experian Business (SBI) score below 73; or Fair, Isaac & Company (SBSS) score below 300). There is no language in the cited passages that teaches determining if a current attribute is single-valued. Neither is there any language in the cited passages that teaches determining if a current attribute is single-valued for each profile attribute. Therefore, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 5, 14 and 23, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

- D. Response to Examiner's assertion that Svancarek and Talbot, taken in combination, teach "wherein if said current attribute is not single-valued, determining said recipient is not entitled if each value of said current attribute and a corresponding value for said recipient miscompare" as recited in claim 8 and similarly in claims 17 and 24, as discussed on page 12 of Examiner's Answer.

As understood by Appellants, the Examiner had previously cited only paragraph [0034] of Svancarek as teaching "wherein if said current attribute is not single-valued, determining said recipient is not entitled if each value of said current attribute and a corresponding value for said recipient miscompare" as recited in claim 8 and similarly in claims 17 and 24. Office Action (9/6/2006), page 10. Appellants addressed the Examiner's citing of paragraph [0034] of Svancarek on pages 15-16 of Appellants' Appeal Brief. The Examiner now appears to further cite paragraphs [0043-0044] of Talbot as teaching the above-cited claim limitation. Examiner's Answer, page 12. Appellants respectfully traverse.

Talbot instead teaches that if it is determined (step 502) that any of the single value exclusions apply, the credit request is filtered out (step 504) and will not be shown to that lender. [0043]. Talbot further teaches that if none of the single value exclusions apply, the credit request will be filtered by a second-pass filter (filter 2) involving multiple value factors. [0043]. Talbot additionally teaches that single value exclusions include: loan amounts below \$500,000; loan amounts above \$5,000,000; delinquent taxes; bankruptcy; Experian Business (SBI) score below 73; or Fair, Isaac & Company (SBSS) score below 300. [0036-0042]. Talbot further teaches that if it is determined (step 508) that any of the multiple value exclusions apply, the credit request is filtered out (step 506) and will not be shown to that lender. [0044]. Hence, Talbot teaches determining if a single value exclusion apply (e.g., loan amounts below \$500,000; loan amounts above \$5,000,000; delinquent taxes; bankruptcy; Experian Business (SBI) score below 73; or Fair, Isaac & Company (SBSS) score below 300). Talbot further teaches determining if any of the multiple value exclusions apply.

There is no language in the cited passage that teaches determining the recipient is not entitled if each value of the current attribute and a corresponding value for the recipient miscompare. Neither is there any language in the cited passage that teaches where if the current attribute is not single-valued, determining the recipient is not entitled if each value of the current attribute and a corresponding value for the recipient miscompare. Therefore, the Examiner has not presented a

prima facie case of obviousness in rejecting claims 8, 17 and 24, since the Examiner is relying upon incorrect, factual predicates in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

E. Response to Examiner's assertion that Talbot is analogous prior art, as discussed on pages 13-14 of Examiner's Answer.

The Examiner acknowledges that the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art, and all teachings in the prior art must be considered to the extent that they are in analogous arts. M.P.E.P. §2143.01. The Examiner further acknowledges that in order to rely on a reference as a basis for rejection under 35 U.S.C. §103(a), the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. *In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992). The Examiner asserts that Talbot is the field of business methods and therefore is analogous art. Examiner's Answer, page 14. Appellants respectfully traverse. Appellants' field of endeavor is clearly not in the field of business methods¹. As stated in Appellants' Appeal Brief, the Talbot reference addresses the problem of providing reverse blind electronic credit auctions providing for financial institution bidding using masked credit reports. [0002]. Appellants, on the other hand, address the problem of managing entitlements associated with packages of services. Specification, page 3, lines 11-27. Hence, the Talbot reference is not in the same field as Appellants' endeavor and is not reasonably pertinent to solving the problem of managing entitlements associated with packages of services. As a result, the Talbot reference is not an analogous prior art and the Examiner has not established a *prima facie* case of obviousness in rejecting claims 5, 8, 14, 17, 23 and 24. M.P.E.P. §2141.01; 2143.01.

¹ Appellants' Specification (page 1, lines 5-8) states "[t]he present invention relates in general to data processing systems, and in particular, to data processing systems for the management and tracking of customer relationship and partner relationship benefits delivered electronically, such as benefits delivered in the form of web objects or web content."

F. Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellants' Appeal Brief (2/5/2007) and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION:

For the reasons stated above and in Appellants' Appeal Brief (2/5/2007), Appellants respectfully assert that the rejections of claims 1-25 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 1-25.

Respectfully submitted,

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